

way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The Applicant respectfully disagrees with the Examiner's finding. The Examiner stated that "there is a high degree of error in determining the amount of inorganic substances such as titanium in a polypropylene polymer sample" according to Example 3 in Masino. However, Example 3 recites that the observed productivity is inconsistent with the observed high residual titanium content of the product, and is probably due to high degrees of experimental error (see Masino, column 12, lines 35-40). The term "high residual titanium content" is not quantified in Masino, and Applicant is not sure how the Examiner has considered the Applicant's disclosure as having a "high residual titanium content." The high degree of experimental error is referring to the observed high productivity, and not the titanium content. Furthermore, Masino recites that experimental error is attributed to the observed high productivity. The term "experimental error" can have numerous interpretations, and all of the potential factors implemented in a given experiment should be considered. Furthermore, the Applicant recites the inclusion of such inorganic residue in its Examples 1 and 2. The Applicant's specification recites the manner of making and using the invention of Claim 3 in such terms so as to enable any person skilled in the art to make and use the same. The Applicant respectfully requests that the Examiner withdraw the rejection of Claim 3 under 35 U.S.C. §112, first paragraph.

EXAMINER REJECTION #7, 8 – 35 U.S.C. §103

The Examiner rejected Claims 1,2,5-8 under 35 U.S.C. §103(a) as being unpatentable over McCullough et al. (WO 00/12605) in view of Ushioda et al. (US 6,410,662 B1).

The Applicant respectfully disagrees with the Examiner's finding. To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

in McCullough
was forming
(Col 15, line 9-12)
in Ushioda et al.

The composition recited by the Applicant in Claim 1 is distinguishable from the composition recited in McCullough. The Applicant's composition, as stated above, is free or essentially free of phenolic antioxidant. By contrast, the composition in McCullough recites that "antioxidants which may be most useful in the compositions of the present invention include primary antioxidants of phenolic type" (see McCullough, page 7, par.2, lines 8-9). Furthermore, the Examiner stated that the above quoted language from McCullough did not exist. However, the Applicant respectfully directs the Examiner to the lines recited above as proof that such language does exist.

*It does not
recite
antioxidant
as primary
antioxidant*

The inclusion of a nucleating agent from Ushioda into the invention of McCullough does not render Applicant's claims obvious over the combination of the cited references. The suggestion to combine the reference teachings does not lead to a reasonable expectation of success. Imparting the teachings from Ushioda of utilizing a nucleating agent into McCullough is improper here because the invention recited in McCullough, as stated above, is distinguishable from the Applicant's claimed invention. In addition, the Examiner states that Examples 4-6 of McCullough disclose polypropylene compositions containing no phenolic antioxidant. Examples 4-6 recite the inclusion of the antioxidant tris (2,4-di-tert-butylphenyl) phosphite. This antioxidant does contain a phenyl group, and thus the Applicant respectfully disagrees with the Examiner that Examples 4-6 do not recite compositions containing no phenolic antioxidant. Teaching the inclusion of a nucleating agent into a composition that is different from the Applicant's claimed composition does not render the Applicant's claimed invention obvious. The Applicant respectfully requests that the Examiner withdraw the rejection of Claims 1-2, 5-8 under 35 U.S.C. §103(a).

*direct to
patent 8 of
to use rejection*

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EXAMINER REJECTION #9 – 35 U.S.C. §103

The Examiner rejected Claim 3 under 35 U.S.C. §103(a) as being unpatentable over McCullough et al. (WO 00/12605) in view of Ushioda et al. (US 6,410,662 B1) and further in view of Masino (US 5,182,341).

The Applicant respectfully disagrees with the Examiner's finding. The combination of the teachings from Ushioda and McCullough, namely imparting the teachings of using nucleating agents, has already been discussed above in the remarks about "Examiner Rejection #7, 8." As for the teachings of Masino, the Examiner stated that "since Masino indicates that the preparation of a high melt flow polypropylene requires an amount of inorganic catalyst materials for

carrying out the polymerization process, Masino clearly indicates that a propylene polymer such as the high melt flow polypropylene of McCullough would also contain a specific amount of inorganic residue.” However, the Applicant’s claimed invention does not include a recitation of a high melt flow polypropylene with a specific melt flow as in Claim 1 of McCullough. In addition, McCullough does not recite a clarifying agent as part of its composition. Furthermore, as stated in remarks about “Examiner Rejection #7, 8” the composition claimed in McCullough is distinguishable from that of the Applicant’s invention. The combination of the above-mentioned references does not teach nor suggest the claim limitations of the Applicant’s invention. The Examiner also stated that since the Applicants’ specification “does not indicate the criticality of the claimed inorganic residue range, the rejection set forth is proper.” However, the specification need not necessarily disclose proportions or ranges in a composition claim as critical in order for them to be considered as such, Jennings v. Brenner, Comr. Pats. (DCDC 1966), 555 F. Supp. 410, 150 USPQ 167; Scandiamant Aktiebolag v. Comr. Pats., (CADC 1974), 509 F.2d 463, 184 USPQ 201; In re Saunders et al. (CCPA 1971) 444 F.2d 599, 170 USPQ 213.

EXAMINER REJECTION #10 – 35 U.S.C. §103

The Examiner rejected Claims 1 and 4 under 35 U.S.C. §103(a) as being unpatentable over Kobayashi et al. (US 6,238,615 B1).

The Applicant respectfully disagrees with the Examiner’s finding. The Examiner states that Kobayashi does not suggest that one of ordinary skill in the art must use a stabilizer, especially pertaining to a phenolic antioxidant, and that it would have been obvious to one of ordinary skill in the art that a phenolic antioxidant is not a critical component. However, Kobayashi recites that the present invention may contain other additives such as stabilizers, neutralizing agents, antistatic agents, lubricants, etc...and that these known additives may be used in combination, insofar as they do not adversely affect the effects of the invention (see column 11, lines 66-68; column 7, lines 1-3). Since Kobayashi does disclose the use of phenolic antioxidant in its Example 1, then the use of such would not negatively affect the effects of the invention, according to the specification language cited above. In addition, Examples 2 through 6 are also prepared using the procedure in Example 1. In all of the examples in Kobayashi, the inclusion of a phenolic antioxidant is a critical component. By contrast, the Applicant’s invention recites a composition free or essentially free of

phenolic antioxidant. The Applicant's invention recites the propriety of not using such phenolic antioxidants. Thus, it would not have been obvious to one of ordinary skill in the art to use all the teachings in Kobayashi to obtain the invention of claim 1 and 4. The Applicant respectfully requests that the Examiner withdraw the rejection of Claims 1 and 4 under 35 U.S.C. §103(a).

EXAMINER REJECTION #11 – 35 U.S.C. §103

The Examiner rejected Claim 9 under 35 U.S.C. §103(a) as being unpatentable over Kobayashi et al. (US 6,238,615 B1).

The Applicant respectfully disagrees with the Examiner's finding. Replacing Kobayashi's sorbitol based nucleating agent with a phosphate based nucleating agent still would not overcome the criticality of having a phenolic antioxidant in the composition, as stated in the remarks about "Examiner rejection #10." Thus, replacing nucleating agents would not overcome the importance of having a phenolic antioxidant in Kobayashi.

The Applicant respectfully requests that the Examiner consider the foregoing arguments. Applicant submits that Claims 1-9 are now in condition for allowance and respectfully request allowance of these claims

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